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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/696,663	10/25/2000	Henry N. Holtzman	PRT-004	4174
21323	7590	01/12/2005	EXAMINER	
TESTA, HURWITZ & THIBEAULT, LLP HIGH STREET TOWER 125 HIGH STREET BOSTON, MA 02110			WINTER, JOHN M	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

P. 2

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/696,663	HOLTZMAN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	John M Winter	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 26 October 2004.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-17 is/are rejected.
- 7) Claim(s) 18-31 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____.   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

**DETAILED ACTION**

Claims 1-31 are pending.

***Response to Arguments***

The Applicants arguments filed on October 24, 2004 have been fully considered.

The amended claims are rejected in view of the newly discovered reference Pare, Jr et al. (US Patent 6,662,166).

See following rejection.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Janning et al. (US patent 6,446,049) in view of O'Hagan (US Patent 6,314,406) and further in view of Daly et al. (US Patent 5,878,141) and further in view of Pare, Jr et al. (US Patent 6,662,166).

As per claim 1,

Janning et al. ('049) discloses a computer-based method for selling an item to a customer at a physical retail location, the method comprising the steps of receiving at the physical retail location an identifier associated with a token presented by a customer at the physical retail location;(Column 8, lines 20-28)

preparing the identified customer order at the retail location;(Figure 1)

executing payment by the customer for the selected order by the preferred payment method;(Column 9, lines 59-67; column 10, lines 1-32)

providing the customer with the selected order at the retail location.(Column 10, lines 35-38)

Janning et al. ('049) does not explicitly disclose identifying in the customer data a product order selected by the customer. O'Hagan ('406) discloses identifying in the customer data a product order selected by the customer (column 20, lines 51-59) It would be obvious to one having ordinary skill in the art at the time of the invention to combine Janning et al.'s method with O'Hagan's teaching of identifying in the customer data a product order selected by the customer in order to more efficiently serve the customer.

Janning et al. ('049) does not explicitly disclose identifying in the customer data a preferred payment method for the customer. Daly et al. ('141) discloses identifying in the customer data a preferred payment method for the customer (Figure 2) It would be

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obvious to one having ordinary skill in the art at the time of the invention to combine Janning et al.'s method with Daly et al's teaching in order to more efficiently serve the customer.

Janning et al. ('049) does not explicitly disclose accessing customer data from a database located somewhere other than the token based on the received identifier associated with the token; Pare Jr. et al ('166) discloses accessing customer data from a database located somewhere other than the token based on the received identifier associated with the token; (Column 12, lines 5-23). It would be obvious to one having ordinary skill in the art at the time of the invention to combine Janning et al.'s method with Pare Jr. et al's teaching of accessing customer data in order to more efficiently serve the customer.

As per claim 2,

Janning et al. ('049) discloses the method of claim 1,  
wherein the token comprises an RFID tag, and step (a) comprises wirelessly reading a RFID tag presented by the customer.(Column 6, lines 15-42; also figure 1)

As per claim 3,

Janning et al. ('049) discloses the method of claim 2,  
wherein the steps are performed in response to a single user action, the single user action comprising presenting the RFID tag to an RFID reader located in the retail location.(Column 8, lines 1-52, also figure 3)

As per claim 4,

Janning et al. ('049) discloses the method of claim 1,  
Official notice is taken that it is old and well known in the art of selling an item to a customer at a retail location that the token comprises a magnetic stripe card, and step (a) comprises reading a magnetic stripe card presented by a customer to a magnetic stripe reader. It would be obvious to one having ordinary skill in the art at the time of the invention to utilize a magnetic card and reader because this is an inexpensive well known method of conducting commerce. The examiner notes that this technique is commonly utilized by any credit or ATM card.

As per claim 5,

Janning et al. ('049) discloses the method of claim 4,  
Official notice is taken that it is old and well know in the art of selling an item to a customer at a retail location that the steps are performed in response to a single user action, the single user action comprising presenting the magnetic stripe card to a customer accessible magnetic stripe card reader located in the retail location. It would be obvious to one having ordinary skill in the art at the time of the invention that a single user action of presenting a magnetic stripe card to a card reader at a retail location would occur because this is an inexpensive and well known method of conducting commerce. The examiner notes that this technique is commonly utilized by any credit or ATM card.

As per claim 6,

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Janning et al. ('049) discloses the method of claim 1,

Janning et al. ('049) does not explicitly disclose the steps of facilitating customer selection of a product order; and associating the customer selected product order with the customer. O'Hagan et al. ('406) discloses the steps of facilitating customer selection of a product order;(Figure 23) and associating the customer selected product order with the customer. (Figure 17) It would be obvious to one having ordinary skill in the art at the time of the invention to combine Janning et al.'s method with O'Hagan et al.'s teaching of facilitating customer selection of a product order and associating the customer selected product order with the customer in order to more efficiently serve the customer.

As per claim 7,

Janning et al. ('049) discloses the method of claim 6,

Janning et al. ('049) does not explicitly disclose facilitating customer selection via the Internet. O'Hagan et al. ('406) discloses facilitating customer selection via the Internet; (Column 3, lines 16-24) It would be obvious to one having ordinary skill in the art at the time of the invention to combine Janning et al.'s method with O'Hagan et al.'s teaching of facilitating customer selection via the Internet because the internet is an inexpensive and efficient medium to reach the customer.

As per claim 8,

Janning et al. ('049) discloses the method of claim 6,

Official notice is taken that it is old and well known in the art of selling an item to a customer at a retail location to facilitate customer selection at a terminal located in the retail location. It would be obvious to one having ordinary skill in the art at the time of the invention to facilitate customer selection at a terminal located in the retail location because this allows the customer to select items from the immediate inventory of the store and prevents aggravation caused by the necessity to order items.

As per claim 9,

Janning et al. ('049) discloses the method of claim 1,

Janning et al. ('049) does not explicitly disclose accessing customer data over the Internet. O'Hagan et al. ('406) discloses accessing customer data over the Internet; (Column 3, lines 16-24). It would be obvious to one having ordinary skill in the art at the time of the invention to combine Janning et al.'s method with O'Hagan et al.'s teaching of accessing customer data over the Internet because reduces the overhead cost of maintaining the store by reducing the number of database servers needed to complete a transaction

As per claim 10,

Janning et al. ('049) discloses the method of claim 1,

Janning et al. ('049) does not explicitly disclose accessing customer data over a local area network. O'Hagan et al. ('406) discloses accessing customer data over a local area network; (Figure 17) It would be obvious to one having ordinary skill in the art at the time of the invention to combine Janning et al.'s method with O'Hagan et al.'s teaching of accessing customer data over a local area network because reduces the

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overhead cost of maintaining the store by reducing the number of database servers needed to complete a transaction

As per claim 11,

Janning et al. ('049) discloses the method of claim 1,

Janning et al. ('049) does not explicitly disclose accessing customer data from a local database. O'Hagan et al. ('406) discloses accessing customer data from a local database. (Figure 17) It would be obvious to one having ordinary skill in the art at the time of the invention to combine Janning et al.'s method with O'Hagan et al.'s teaching of accessing customer data from a local database because increased the reliability of the system by allowing information to be accessible even if the network is inoperable.

As per claim 12,

Janning et al. ('049) discloses the method of claim 1,

Official notice is taken that it is old and well known in the art of selling an item to a customer at a retail location to access customer data from a database operated from a third party service provider. It would be obvious to one having ordinary skill in the art at the time of the invention to access customer data from a database operated from a third party service provider because this is a cost effective way to verify the credentials of customer. The examiner notes that this feature is routinely provided by credit rating services such as Equifax.

As per claim 13,

Janning et al. ('049) discloses the method of claim 1,

Janning et al. ('049) does not explicitly disclose providing payment information to a POS device for execution. O'Hagan et al. ('406) discloses providing payment information to a POS device for execution. (Figure 18) It would be obvious to one having ordinary skill in the art at the time of the invention to combine Janning et al.'s method with O'Hagan et al.'s teaching of providing payment information to a POS device for execution because this allows the merchant to realize a profit on the transaction

As per claim 14,

Janning et al. ('049) discloses the method of claim 1,

Official notice is taken that it is old and well known in the art of selling an item to a customer at a retail location to process payment and provide an execution code indicating complete payment to a POS device. It would be obvious to one having ordinary skill in the art at the time of the invention to process payment and provide an execution code indicating complete payment to a POS device because this allows the merchant to realize a profit on the transaction. The examiner notes that this feature is common to a majority POS systems.

As per claim 15,

Janning et al. ('049) discloses the method of claim 1,

Official notice is taken that it is old and well known in the art of selling an item to a customer at a retail location to obtain a count value associated with the token and if the

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count value is greater than zero, decrementing the count value. It would be obvious to one having ordinary skill in the art at the time of the invention to obtain a count value associated with the token and if the count value is greater than zero, decrement the count value because this encourages the customer loyalty. The examiner notes that this feature is common to promotional sales programs where the customer is “rewarded” after a certain number of purchases are made.

Claims 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over O’Hagan et al. (US Patent 6,314,406) in view of Janning et al. (US patent 6,446,049) and further in view of Daly et al. (US Patent 5,878,141).

As per claim 16,

O’Hagan et al. (‘406) discloses a system for selling an item at a retail location, comprising the steps of

identifying in the customer data a selected customer order and a preferred payment method; (Figures 27 and 18)

a display for displaying the selected customer order at the retail location to a retail clerk; (Figure 18)

O’Hagan et al. (‘406) does not explicitly disclose a token reader for receiving at the physical retail location an identifier associated with token presented by the customer at the physical location . Janning et al. (‘049) discloses a token reader for receiving at the physical retail location an identifier associated with token presented by the customer at the physical location . (Figure 16) It would be obvious to one having ordinary skill in the art at the time of the invention to combine O’Hagan et al.’s device with Janning’s teaching of a token reader for receiving at the retail location an identifier associated with token presented by the customer in order to more efficiently serve the customer.

O’Hagan et al. (‘049) does not explicitly disclose a POS device for executing payment by the customer for the selected customer order by the preferred payment method. Daly et al. (‘141) discloses identifying in the customer data a preferred payment method for the customer (Figure 2) It would be obvious to one having ordinary skill in the art at the time of the invention to combine O’Hagan et al.’s system with Daly et al’s teaching in order to more efficiently serve the customer.

Janning et al. (‘049) does not explicitly disclose a dispatch module for accessing customer data from a database located somewhere other than the token based on the received identifier associated with the token; Pare Jr. et al (‘166) discloses a dispatch module for accessing customer data from a database located somewhere other than the token based on the received identifier associated with the token; (Column 12, lines 5-23). It would be obvious to one having ordinary skill in the art at the time of the invention to combine Janning et al.’s method with Pare Jr. et al’s teaching of accessing customer data in order to more efficiently serve the customer.

As per claim 17,

O’Hagan et al (‘406) discloses the system of claim 16

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further comprising a database server in communication with the dispatch module over a computer network for providing customer data in response to a request comprising an identifier.(Figure 17)

***Allowable Subject Matter***

Claims 18-31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and complying with double patenting statutes.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

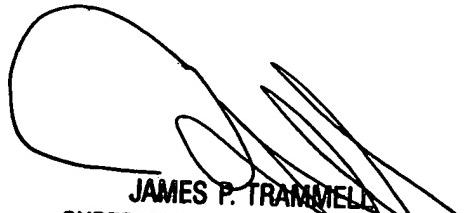
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M Winter whose telephone number is (703) 305-3971. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on (703) 305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

JMW  
January 9, 2005.



JAMES P. TRAMMELL  
SUPERVISORY PATENT EXAMINER  
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